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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS

In re Reissue Patent Application
for Patent No. 5,711,100

WILLIAM A. ELMER

Serial No. 10/098,648

Filing Date: March 15, 2002

For: **VEHICLE ADVERTISING SIGN, SYSTEM
AND METHOD**

Examiner: **Brian K. Green**

Art Unit: **3611**

Attorney Docket No.
8588.12RE

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

APPELLANT'S REPLY BRIEF

Pursuant to the provisions of 37 CFR §41.41, Appellant submits this brief in reply to the Examiner's Answer (herein "the Answer") mailed on December 12, 2007.

I. Preliminary Note Regarding the EP '194 Reference

Neither the Examiner nor Appellant's undersigned counsel had a translated copy of the EP '194 reference. Therefore, the Examiner and Appellant's undersigned counsel during a telephone conversation agreed that the Canadian counterpart of the EP '194 reference could be used for purposes of evaluating that reference (see page 13 of Appellant's Amended Brief). However, the Answer now includes a translated copy of the

EP '194 reference. Appellant's undersigned counsel has carefully compared the translated copy appended to the Answer with the Canadian counterpart and makes the following observations.

First, the arguments in Appellant's brief referred to element **115** in Figure 6 of the EP '194 reference using the following language in the Canadian counterpart:

It is advisable, furthermore, to attach the permanent magnets **112** on the base area **3** of the box **1** in such a manner that they are spatially movable at least in a restricted manner. *This may be effective for each magnet by way of a resilient member, for instance a cylindrical member **115** of rubber which has a restricted diameter in its middle portion.* Anchoring of each permanent magnet **112** is effected by means of a bolt **117** extending through the central bore of the member **115**, with the associated nut **116** being received in the associated rail **113** or **114** of C-shaped profile. *The member **115** is molded onto the permanent magnet **112**.*¹

The translation attached to the Answer states as follows:

It is further recommended to mount the permanent magnet **112** spatially so that it can move at least to a limited extent on the base surface **3** of the box **1**. *This can be realized by means of an elastic body, for example, a cylindrical (diabolo-shaped) element **115** made from rubber, which has, for example, a reduced diameter in the middle region.* Each permanent magnet **112** is anchored by means of a screw **117** passing through the central borehole of the element **115**, wherein the allocated nut **116** is held in the associated rail **113** or **114** of a C-shaped profile. *The element **115** is molded onto the permanent magnet **112**.*²

Appellant's undersigned counsel has carefully studied the translation attached to the Answer and can find no reference to the words "flexible" or "sleeve" therein as argued

¹Appellant's brief, Appendix B, tab 3, page 6 (emphasis added).

²Translation, page 6 (emphasis added).

at the bottom of page 6 of the Answer, nor is there any suggestion in either version that the magnet pivots about the bolt 117.

II. As to Claim 2, the Answer Relies Upon an Alleged Inherent Teaching

Claim 2 recites an advertising sign having, *inter alia*, “a pivotal attaching means (that) comprises a flexible sleeve between each magnet and the base.” The EP ‘194 reference is totally devoid of any teaching that the member 115 achieves a pivotal attachment of the magnet to the sign body; all that is described is that the element 115 is either an “elastic body” (the translation) or a “resilient member” (the Canadian counterpart) that is “molded” on top of the magnet 112. That description alone does not render element 115 in the EP ‘194 reference “a flexible sleeve” that *explicitly* achieves pivoting. Indeed, the argument at the bottom of page 6 of the Answer effectively admits that the reference does not teach pivoting, but instead argues that element 115 in the EP ‘194 reference “is *inherently* able to pivot...” (emphasis added). The secondary reference to U.S. Patent 4,052,806 to George adds nothing to the inquiry regarding Claim 2, since the George reference is permanently bolted to the automobile roof top (see George reference, Figure 3).

Appellant’s brief was submitted on April 9, 2007, three weeks before the Supreme Court published its opinion in KSR International Co. v. Teleflex, Inc., 127 S.Ct. 1727, 207 U.S. LEXIS 4745, 82 USPQ 2d 1385 (2007). In the KSR decision, the Supreme Court restated the basis upon which patentability under 35 U.S.C. §103 is to be analyzed. Specifically, the Court enunciated certain principles to be used in making the §103

analysis. Appellant respectfully submits that under these principles, Claim 2 clearly defines non-obvious subject matter.

III. As to Claim 3, the Answer Relies Upon a Disingenuous Argument

Claim 3 depends upon Claim 2 and recites that “the pivotal attaching means comprises a fastener extending through each magnet, its flexible sleeve and into the base.” Even a casual review of Figure 6 of the EP ‘194 reference clearly illustrates that the fastener 117 does not extend through the magnet. At page 7 of the Answer, it is argued that “the fastener is attached by being passed through the cylinder 115. Therefore, it extends through it.” However, this is a *method* argument with respect to an *apparatus* claim. The apparatus that is recited in Claim 3 calls for a final construction having a fastener that extends through the magnet, its flexible sleeve and into the base. Respectfully, the EP ‘194 reference does not disclose the *apparatus* of Claim 3.

IV. The Answer is Devoid of Any Argument as to Claims 20-25

Claim 20 depends upon Claim 3 through Claim 19 and further recites that “all of the magnets (are) pivotal about an outer extremity of the respective fastener.” The Answer makes no argument with respect to Claim 20, and Appellant again submits that the EP ‘194 reference is devoid of any suggestions for providing a construction *where the magnets are pivotal about an outer extremity of the fastener*.

Claim 21 depends upon Claim 20 (and thus Claim 3) and recites that “each fastener comprises a beveled head to facilitate pivoting of the respected (sic: respective) magnet.”

No response is contained in the Answer to Appellant's challenge to the "design choice" argument made in the final rejection of Claim 21. These remarks also apply to Claim 24, which likewise depends upon Claim 3.

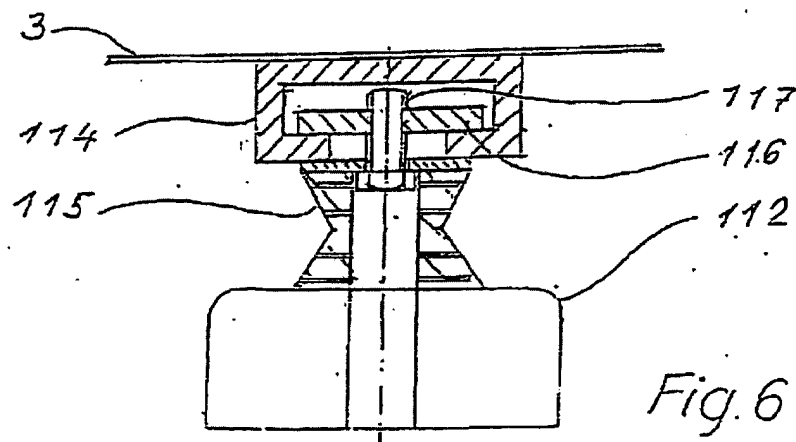
Claim 25 depends upon Claim 3 through Claim 24 and recites that each magnet is recessed toward the base relative to the portions of the adjacent side and adjacent end of the side, and an opposite bottom magnet side extends below portions of the adjacent side and adjacent end. The Answer does not contain any response to Appellant's argument with respect to Claim 25, and it is clear that the EP '194 reference does not disclose the recessed features specifically recited in Claim 25. Indeed, Appellant respectfully submits that it is a distortion of the teachings of the EP '194 reference to suggest that the magnets 112 are recessed *in any manner* relative to the side surfaces 2 or the base surface 3 of either the embodiment shown in Figures 1-3 or that shown in Figures 4-6.

V. The Answer Fails to Give Appropriate Consideration to Appellant's Affidavit Evidence

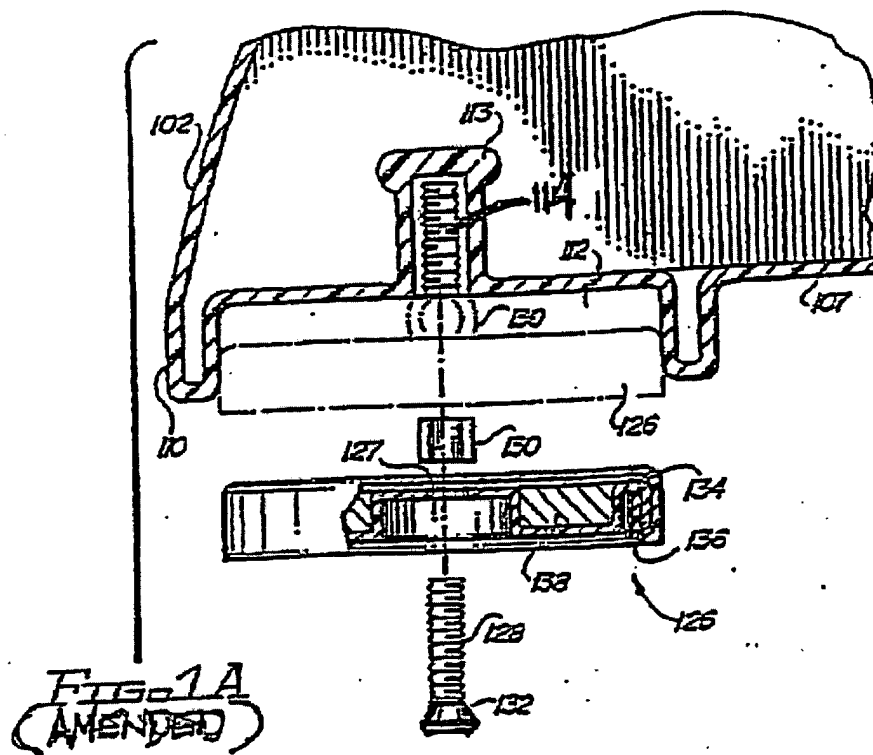
Appendix B to Appellant's brief contains significant evidence that demonstrates the technical deficiencies in the EP '194 reference as well as establishing clear commercial success for Appellant's invention. With due respect, Appellant submits that the Answer improperly treats (or ignores) this evidence.

VI. Summary and Conclusion

The Supreme Court's KSR decision instructs lower courts to evaluate the obviousness issue with a practical, real-world view; there is nothing in these instructions that preclude a finding of non-obviousness for a simple, elegant construction that is not found in the prior art. Appellant respectfully submits that after a comparison of the magnet assembly in the EP '194 reference with that of Appellant, the striking differences become readily apparent. These two drawings follow next:



EP '194 - FIG. 6

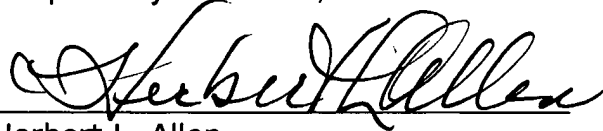


APPELLANT'S FIGURE 1A

Clearly, Appellant's construction is simple, facile and easily achieves the goal of permitting the pivoting of the magnet 138 about the head 132 of the fastener 128. Respectfully, the EP '194 reference is devoid of any teaching that the disclosed structure achieves this objective.

Appellant respectfully submits that, under the guidelines of the KSR decision, the claims on appeal patentably distinguish over the applied references. Reversal of the final rejection is therefore respectfully solicited.

Respectfully submitted,



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